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27386 7590 02/04/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC HUSEMANN,
STEPHEN ZOLLNER,
HEIKO THIEDE and
REINHARD STORBECK

Appeal 2007-3917
Application 10/077,658
Technology Center 1700

Decided: February 4, 2008

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and CATHERINE
Q. TIMM, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
decision rejecting claims 1-3 and 5-13. We have jurisdiction under
35 U.S.C. § 6.

We REVERSE.

Appellants claim a UV crosslinked pressure-sensitive adhesive composition having a residue volatile component fraction of less than 50 $\mu\text{g/g}$, as measured by the tesa method (claim 1). Appellants also claim a process for preparing such a composition (claim 3) as well as an adhesive tape comprising such a composition (claim 9).

Representative claim 1 reads as follows:

1. A UV crosslinked pressure-sensitive adhesive composition comprising polymers, copolymers, or both, based at least predominantly on (meth)acrylic acid, derivatives thereof, or both, wherein said crosslinked pressure-sensitive adhesive composition comprises a residual volatile component fraction of in total less than 50 $\mu\text{g/g}$, as measured by the tesa method.

The references set forth below are relied upon by the Examiner in the § 102 and § 103 rejections before us:

Harder et al (Harder)	DE 4,313,008 ¹	Nov. 10, 1994
Harder et al (Harder)	DE 19807752 ²	Aug. 26, 1999
Meyer-Roscher	6,242,504 B1	Jun. 5, 2001

Claims 1, 2, and 9-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively under 35 U.S.C. § 103(a) as being unpatentable over, Harder (DE '752; US '529).

¹ In discussing this reference, both Appellants and the Examiner cite to US Patent No. 6,613,870 to Harder et al. (Harder) as the English language equivalent. We shall do likewise.

² In discussing this reference, both Appellants and the Examiner cite to US Patent No. 6,432,529 B1 to Harder et al. (Harder) as the English language equivalent. Again, we shall do likewise.

Claims 3 and 5-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harder (DE '752; US '529) in view of Harder (DE '008; US '870) and further in view of Meyer-Roscher.

Both of these rejections are based on an inherency theory. According to the Examiner, "since Harder [DE '752; US ' 529] discloses the same composition and further teaches that adhesive is low in fogging (i.e., low outgassing level), presumably, Harder[']s ... adhesive would inherently possess the claimed outgassing level [of less than 50 $\mu\text{m/g}$ as in claim 1]" (Ans. 3). We can not agree.

The Examiner's inherency theory is contraindicated by the teachings of Harder (DE '752; US '529) which relate to achieving a nonfogging or low fogging composition having a residual solvent content below 1% by weight (col. 3, ll. 64-65). A 1% by weight quantity is orders of magnitude greater than the claim 1 quantity of less than 50 $\mu\text{g/g}$. The fact that Harder teaches achieving a nonfogging goal with a residual solvent content expressed in the aforementioned terms of weight percent convincingly indicates that the desired nonfogging result is accomplished with residual solvent contents orders of magnitude higher than the maximum residual volatile component amount required by claim 1.

For these reasons, Harder (DE '752; US '529) does not support the Examiner's inherency position and concominantly does not inherently anticipate or render obvious the residual volatile component fraction required by claim 1. It follows that we can not sustain the § 102 and § 103 rejections of claims 1, 2, and 9-11 based on this reference.

We also can not sustain the § 103 rejection of claims 3 and 5-13 as being unpatentable over Harder (DE '752; US '529) in view of Harder (DE '008; US '870) and further in view of Meyer-Roscher. While Harder (DE '008; US '870) discloses a process for preparing adhesive compositions which is similar to the claim 3 process, the prior art process is practiced in such a way that the resulting polymer contains 0.8 % volatile substances (col. 3, ll. 23-24 and 36). Again, this amount of volatile substances is orders of magnitude greater than the amount achieved by the process of claim 3/1 (i.e., less than 50 µg/g). Therefore, the prior art process would not inherently achieve and would not have suggested a residual volatile component fraction of less than 50 µg/g as required by the claims under review in this rejection. Moreover, this deficiency is not remedied by Meyer-Roscher.

The decision of the Examiner is reversed.

REVERSED

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